

REMARKS/ARGUMENTS

The Office has identified the following groups and is requiring an election of one of the same.

Group I: Claims 1-7, drawn to a method for hydraulic transfer printing; and
Group II: Claims 8-20, drawn to a hydraulic transfer printing base film.

Applicants elect with traverse Group II, Claims 8-20, for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office alleges that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The common technical feature linking groups I and II are floating a transfer sheet comprising PVA on the surface of an aqueous solution. However, US 4231829 to Marui et al teaches a process of transfer printing wherein a pattern is printed on a thin film of polyvinyl alcohol by pressing the object to the thin film floated on a surface of water. Therefore, the common technical features are not special technical features.

Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states, emphasis added:

The expression “special technical feature” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, *considered*

as a whole, makes over the prior art. The determination is made on the contents of the claims as *interpreted in light of the description* and drawings (if any).

Applicants respectfully submit that the Office did not consider the contribution of each invention, *as a whole*, in alleging the lack of a special technical feature. Applicants also respectfully submit that the Office has not provided any indication that the contents of the claims *interpreted in light of the description* were considered in making this allegation. Therefore, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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